

*Application No. 10/813219*

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*Amendment*

*Attorney Docket No. O11.2B-11521-US01*

**Amendments To The Drawings:**

**None**

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**Remarks**

This Amendment is in response to the Office Action dated April 26, 2006.

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***35 USC 112 rejections***

Claim 21 has been amended to address this rejection.

***35 USC 102(b)/103(a) rejections***

**(i) GB2371555**

The reference polyoxyethylene polyoxypropylene alkyl ether is obtained by addition polymerization of propylene oxide and ethylene oxide with a linear or branched higher alcohol (see page 9, lines 23-27). Thus, the alkyl group R in the reference polyoxyethylene polyoxypropylene alkyl ether is a residue obtained by removing a hydroxyl group (OH) from the higher alcohol.

In contrast, the claimed reaction product is produced by a reaction between polyalkylene oxide and glycerin, 1,2,3-trimethoxy propane, ethylene glycol, 1,2-diethoxy ethane, diethyl ether or methyl acetate and includes polyoxyethylene polyoxypropylene alkyl ether. However, the polyoxyethylene polyoxypropylene alkyl ether is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether as explained below.

Glycerin,  $\text{HOCH}_2\text{CH}(\text{OH})\text{CH}_2\text{OH}$ , has a number of carbon atoms of 3 and has no alkyl group. Since glycerin has no alkyl group, the reaction product produced by a reaction between polyalkylene oxide and glycerin includes no polyoxyethylene polyoxypropylene alkyl ether. Accordingly, the reaction product produced by a reaction between polyalkylene oxide and glycerin is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether.

1,2,3-trimethoxy propane,  $\text{MeOCH}_2\text{CH}(\text{OMe})\text{CH}_2\text{OMe}$ , has a number of carbon atoms of 6 and has three methyl groups. The reaction product produced by a reaction between polyalkylene oxide and 1,2,3-trimethoxy propane includes polyoxyethylene polyoxypropylene

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alkyl ether. However, since the alkyl groups contained in 1,2,3-trimethoxy propane are methyl groups, said polyoxyethylene polyoxypropylene alkyl ether is inevitably polyoxyethylene polyoxypropylene methyl ether. That is, the alkyl group in said polyoxyethylene polyoxypropylene alkyl ether is methyl group and differs substantially from the alkyl group R in the reference polyoxyethylene polyoxypropylene alkyl ether. Accordingly, the reaction product produced by a reaction between polyalkylene oxide and 1,2,3-trimethoxy propane is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether.

Ethylene glycol, HOCH<sub>2</sub>CH<sub>2</sub>OH, has a number of carbon atoms of 2 and has no alkyl group. Since ethylene glycol has no alkyl group, the reaction product produced by a reaction between polyalkylene oxide and ethylene glycol includes no polyoxyethylene polyoxypropylene alkyl ether. Accordingly, the reaction product produced by a reaction between polyalkylene oxide and ethylene glycol is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether.

1,2-diethoxy ethane, EtOC(CH<sub>2</sub>)<sub>2</sub>OEt, has a number of carbon atoms of 6 and has two ethyl groups. The reaction product produced by a reaction between polyalkylene oxide and 1,2-diethoxy ethane includes polyoxyethylene polyoxypropylene alkyl ether. However, since the alkyl groups contained in 1,2-diethoxy ethane are ethyl groups, said polyoxyethylene polyoxypropylene alkyl ether is inevitably polyoxyethylene polyoxypropylene ethyl ether. That is, the alkyl group in said polyoxyethylene polyoxypropylene alkyl ether is ethyl group and differs substantially from the alkyl group R in the reference polyoxyethylene polyoxypropylene alkyl ether. Accordingly, the reaction product produced by a reaction between polyalkylene oxide and 1,2-diethoxy ethane is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether.

Diethyl ether, EtOEt, has a number of carbon atoms of 4 and has two ethyl groups. The reaction product produced by a reaction between polyalkylene oxide and diethyl ether includes polyoxyethylene polyoxypropylene alkyl ether. However, since the alkyl groups contained in diethyl ether are ethyl groups, said polyoxyethylene polyoxypropylene alkyl ether is inevitably polyoxyethylene polyoxypropylene ethyl ether. That is, the alkyl group in said polyoxyethylene

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polyoxypropylene alkyl ether is ethyl group and differs substantially from the alkyl group R in the reference polyoxyethylene polyoxypropylene alkyl ether. Accordingly, the reaction product produced by a reaction between polyalkylene oxide and diethyl ether is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether.

Methyl acetate,  $\text{MeCOOMe}$ , has a number of carbon atoms of 3 and has two methyl groups. The reaction product produced by a reaction between polyalkylene oxide and methyl acetate includes polyoxyethylene polyoxypropylene alkyl ether. However, since the alkyl groups contained in methyl acetate are methyl groups, said polyoxyethylene polyoxypropylene alkyl ether is inevitably polyoxyethylene polyoxypropylene methyl ether. That is, the alkyl group in said polyoxyethylene polyoxypropylene alkyl ether is methyl group and differs substantially from the alkyl group R in the reference polyoxyethylene polyoxypropylene alkyl ether. Accordingly, the reaction product produced by a reaction between polyalkylene oxide and methyl acetate is distinct from the reference polyoxyethylene polyoxypropylene alkyl ether.

In view of the foregoing, the polishing composition of the claimed invention is not anticipated nor suggested by the reference. Accordingly, the subject matter of all presently pending claims is novel and inventive in view of the reference.

**(ii) Orii et al. US 6,444,132**

The reference discloses two kinds of polishing compositions. One is a first polishing composition comprising a polyol with a molecular weight of from 300 to 20,000, a polishing powder, a dispersion medium, and optionally a surfactant. Another is a second polishing composition comprising a sulfur-containing organomolybdenum compound, a polishing powder, a dispersion medium, and at least one member selected from the group consisting of surfactants, polymeric compounds, and surface modifiers. The examiner alleges that "it is the examiner's position that one skilled in the art would have appreciated that the polymeric compounds includes the polyols of the reference, thus the reference, as a whole, reads on the claimed combination." We disagree. Although the reference does not explicitly describe what compounds are included in the polymeric compounds, the polymeric compounds are contextually

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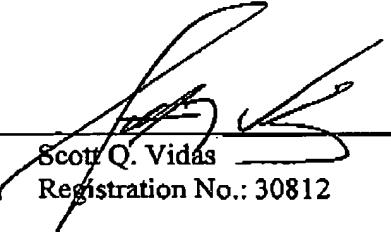
any of surfactants, polymeric surface modifiers, and coupling agents described in column 8, line 9 to column 9, line 36. In addition, since the first and second polishing compositions are distinct from each other, it is unreasonable to state that one skilled in the art would have appreciated that the polymeric compounds (to be contained in the second polishing composition) includes the polyols (to be contained in the first polishing composition). Accordingly, the rejections on the basis of this reference are based on hindsight and are improper.

### Conclusion

It is respectfully submitted that all of the claims, as amended, are patentable over the cited references. Any early notice to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

By: 

Scott Q. Vidas  
Registration No.: 30812

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6109 Blue Circle Drive, Suite 200  
Minnetonka, MN 55343-9185  
Telephone: (952) 563-3000  
Facsimile: (952) 563-3001

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